

Patent Public Advisory Committee Quarterly Meeting

America Invents Act First Inventor To File Roadshow



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Assistant Deputy Commissioner for
Patent Operations
November 20, 2014

AIA First Inventor to File Roadshow Summary

September 16 – October 9, 2014

Concord * Madison * Alexandria * Dallas * Denver * Silicon Valley * Atlanta





AMERICA INVENTS ACT

IMPLEMENTATION

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AIA FITF Roadshow – Report out

- 4 AIA FITF training team members traveled to each location along with 1 project manager and 1 executive (in the absence of a local executive)
- Attendance in-person ranged from
 - 32 attendees in Alexandria (not including Webcast audience) to
 - 100 attendees in Atlanta
- Average in-person attendance was 64 attendees
- Webcasts reached 400 attendees
- Total audience reached = about 850 over the course of the 4 weeks
- Additional events were organized at most roadshow stops, for example:
 - Franklin Pierce law student workshop
 - Coffee with Wisconsin Alumni Research Foundation (WARF)
 - Dinner with Wisconsin State Bar
 - Breakfast with Denver State Bar
 - Meet and Greet with Georgia Tech Students



AIA FITF Roadshow

Half Day Agenda

Topic

Introductory Remarks

FITF – A Year *Plus* In Review

- Review of examiner training
- Statistics to date

Will My Application Be Examined Under AIA (FITF) Or Not?

- 1.55/1.78 Statements
- The power of the ADS
- Have you checked your filing receipt?
- Scenarios

BREAK

FITF Overview and Tips on Responding to Prior Art Rejections

- 35 USC 102(a)(1) and 102(a)(2) – bases for rejections
- 35 USC 102(b)(1) and 102(b)(2) – exceptions
- Scenarios

Effective Use of AIA (FITF) Evidentiary Declarations

- 37 CFR 130(a) and 130(b)
- Scenarios

Tour of the AIA (FITF) Website and Q&A





America Invents Act First Inventor to File Roadshow

FITF – A Year *Plus* In Review



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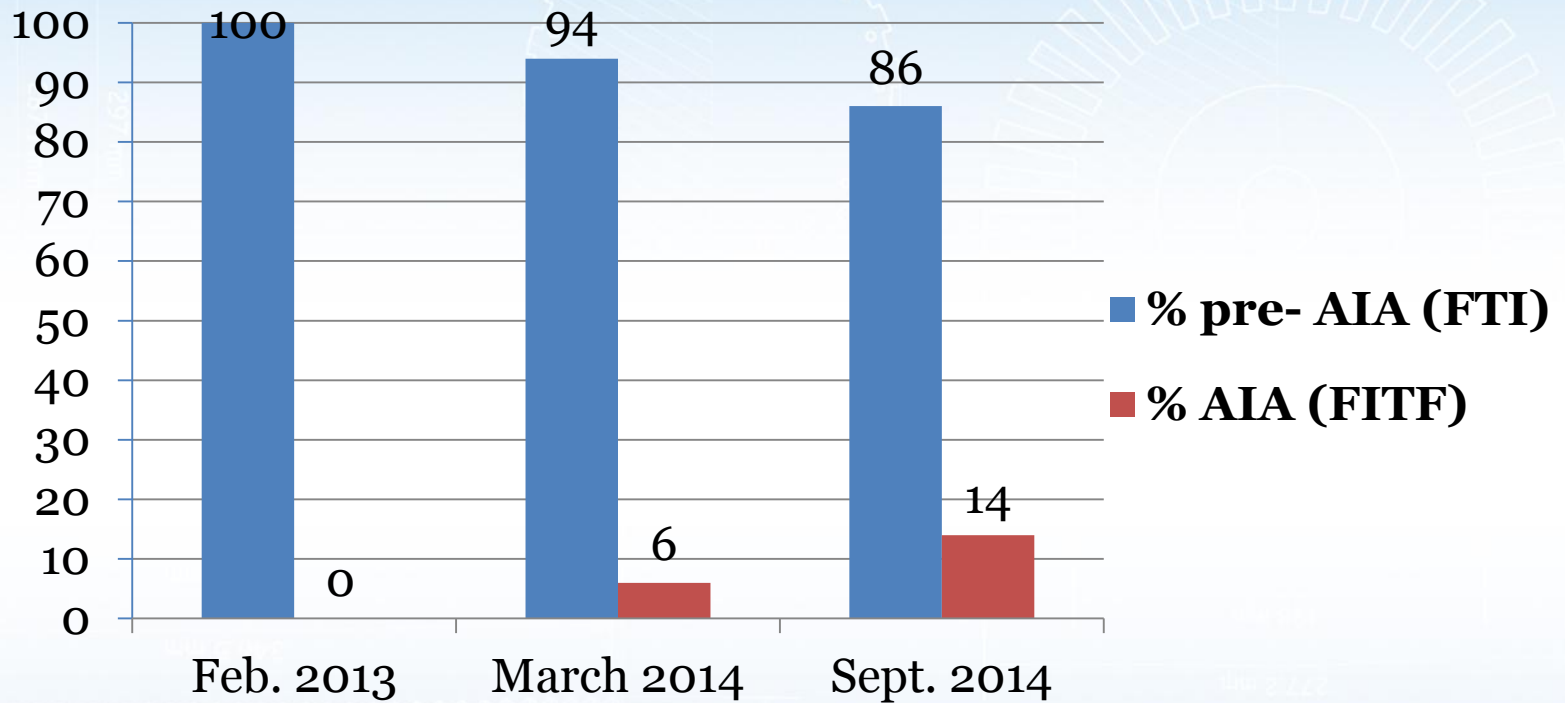
Agenda Excerpts – Review of Examiner Training

- FITF Overview Training (March 2013)
- FITF Comprehensive Training (Summer 2013)
- FITF Hands-On-Workshop (HOW) (began August 2013 and ongoing)
- AIA (FITF) Indicator Training (January 2014)
- AIA (FITF) Declarations under 37 CFR 1.130 (coming Q1 in FY15)



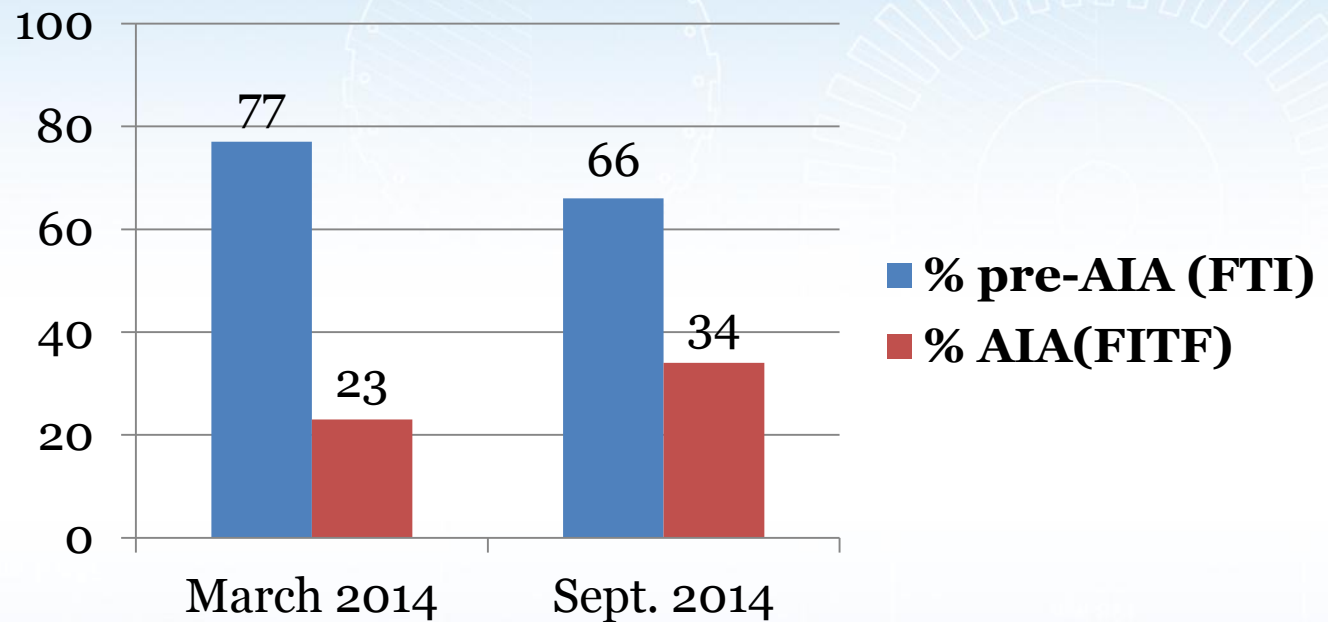
Agenda Excerpts – First Inventor To File (FITF) Statistics

Pending Applications



Agenda Excerpts – First Inventor To File (FITF) Statistics

Applications filed on or after March 16, 2013 *

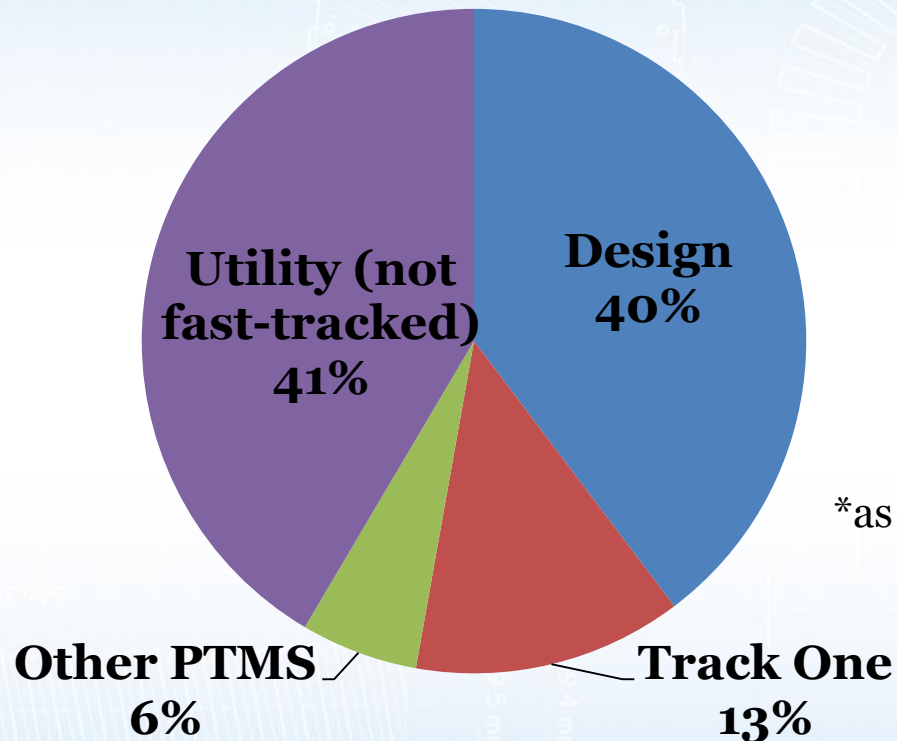


* Pending as of September 2014



Agenda Excerpts – First Inventor To File (FITF) Statistics

**AIA (FITF) Applications having received at least a first action*
% of total**



*as of September 2014





America Invents Act First Inventor to File Roadshow

Will My Application Be Examined Under AIA (FITF) Or Not?

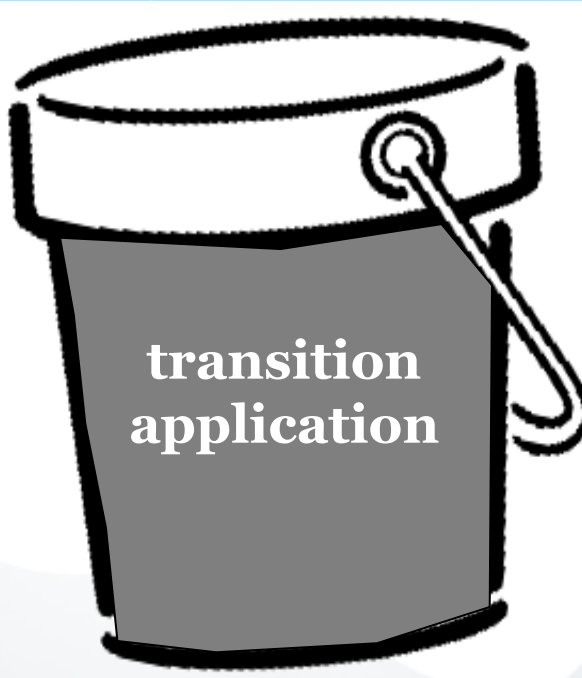


AMERICA INVENTS ACT
IMPLEMENTATION

Agenda Excerpts – AIA (FITF) or Not?



Filed **before** 3/16/2013



Filed **on or after** 3/16/2013
and
AT LEAST ONE foreign
priority or domestic benefit
claim to an appl’n filed
before 3/16/2013



Filed **on or after** 3/16/2013
and
ALL foreign priority or
domestic benefit claims, if any,
are to an appl’n filed
on or after 3/16/2013



Agenda Excerpts – AIA (FITF) or Not for Transition Applications



Pre-AIA transition application

- Only ever contains claimed inventions that have an EFD **before** March 16, 2013

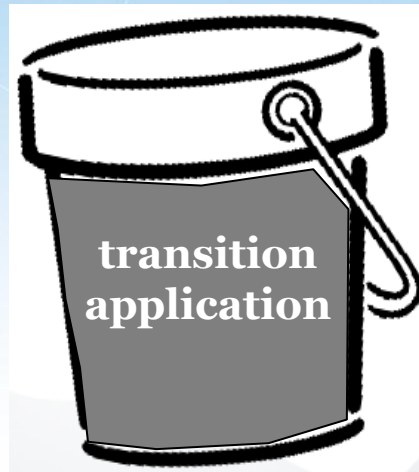
OR

AIA (FITF) transition application

- Contains or ever contained **any** claim to an invention that has an EFD that is **on or after** March 16, 2013 and/or
- Is ever a CON, DIV, or CIP of an AIA (FITF) application



Agenda Excerpts – Making a 1.55/1.78 Statement or Not for Transition Applications



Pre-AIA transition application

- No statement under 37 CFR 1.55/1.78 is filed.

OR

AIA (FITF) transition application

- Statement under 37 CFR 1.55/1.78 is **required**.



Agenda Excerpts – 1.55/1.78 Statement ADS Checkbox

PTO/AIA/14 (03-13)

Approved for use through 01/31/2014. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	
	Application Number	
Title of Invention		

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

☒ This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.

Agenda Excerpts – Tips for Application Data Sheets

- Foreign priority/domestic benefit claims, as claimed on ADSs (required for applications filed on or after September 16, 2012), can directly impact AIA (FITF) status
- Tips included:
 - Checking for typos in application numbers, incorrect filing dates, and wrong relationship types (e.g. CON vs. CIP, etc.)
 - Signature must be present
 - Check the filing receipt provided by the Office for the information that has been captured for the application and make any corrections relative to that filing receipt information
- Demonstrated how to correctly claim priority/benefit on an ADS and how to mark up a corrected ADS



Agenda Excerpts - Tips for Newly Filed Application Data Sheets

This application is a continuation of U.S. Application No. 13/“parent”, filed on 2013-11-19, which was the National Stage of International Application No. PCT/CA2012/xxxxx, filed on 2012-05-16, which claims the benefit of U.S. Provisional Application No. 61/xxx,xxx, filed on 2011-05-2017.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.

When referring to the current application, please leave the application number blank.

Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	13/“parent”	2013-11-19
Prior Application Status		Remove	

No
Relationship
to instant
application



Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.

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Prior Application Status	Pending	Remove	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
13/“parent”	Continuation of		2013-11-19
Prior Application Status		Remove	



Agenda Excerpts - Tips for Corrections to Application Data Sheets

Scenario for correcting an ADS:

Initial filing receipt shows no domestic benefit claims because they were incorrectly entered on the initial ADS. An appropriate and timely, **corrected ADS** with markings to show changes relative to the information of record, as shown below, will be effective.

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.

When referring to the current application, please leave the application number blank.

Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	<u>Continuation of</u>	<u>13/"parent"</u>	<u>2013-11-19</u>
Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
<u>13/"parent"</u>	<u>a 371 of international</u>	<u>PCT/CA2012/XXXXX</u>	<u>2012-05-16</u>
Prior Application Status		<input type="button" value="Remove"/>	
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
<u>PCT/CA2012/XXXXX</u>	<u>Claims benefit of provisional</u>	<u>61/XXX,XXX</u>	<u>2011-05-17</u>

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button.



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FITF Overview and Tips on Responding to Prior Art Rejections



Agenda Excerpts – FITF Overview: ALA Statutory Framework

Prior Art 35 U.S.C. 102(a) (Basis for Rejection)	Exceptions 35 U.S.C. 102(b) (Not Basis for Rejection)	
102(a)(1) Disclosure with Prior Public Availability Date	102(b)(1)	(A) Grace Period Disclosure by Inventor or Obtained from Inventor
		(B) Grace Period Intervening Disclosure by Third Party
102(a)(2) U.S. Patent, Published U.S. Patent Application, and Published PCT Application with Prior Filing Date	102(b)(2)	(A) Disclosure Obtained from Inventor
		(B) Intervening Disclosure by Third Party
		(C) Commonly Owned Disclosures



Agenda Excerpt –

Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

- Dolan filed his patent application on December 16, 2013. The application contains one claim directed to widget X.
- Dolan exhibited his invention of widget X at a trade show on December 30, 2012.
- The examiner locates a U.S. patent application publication disclosing widget X to Flanagan. The application was filed on October 16, 2013 and published on April 23, 2015.



Agenda Excerpt – Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)

December 30, 2012
Dolan's trade show exhibition

October 16, 2013
Flanagan's filing

December 16, 2013
Dolan's filing

April 23, 2015
Flanagan's
PGPub

Dolan's attorney receives an Office action rejecting the claim under 35 U.S.C. 102(a)(2) over Flanagan's patent application publication. How could she properly respond to the Office action?



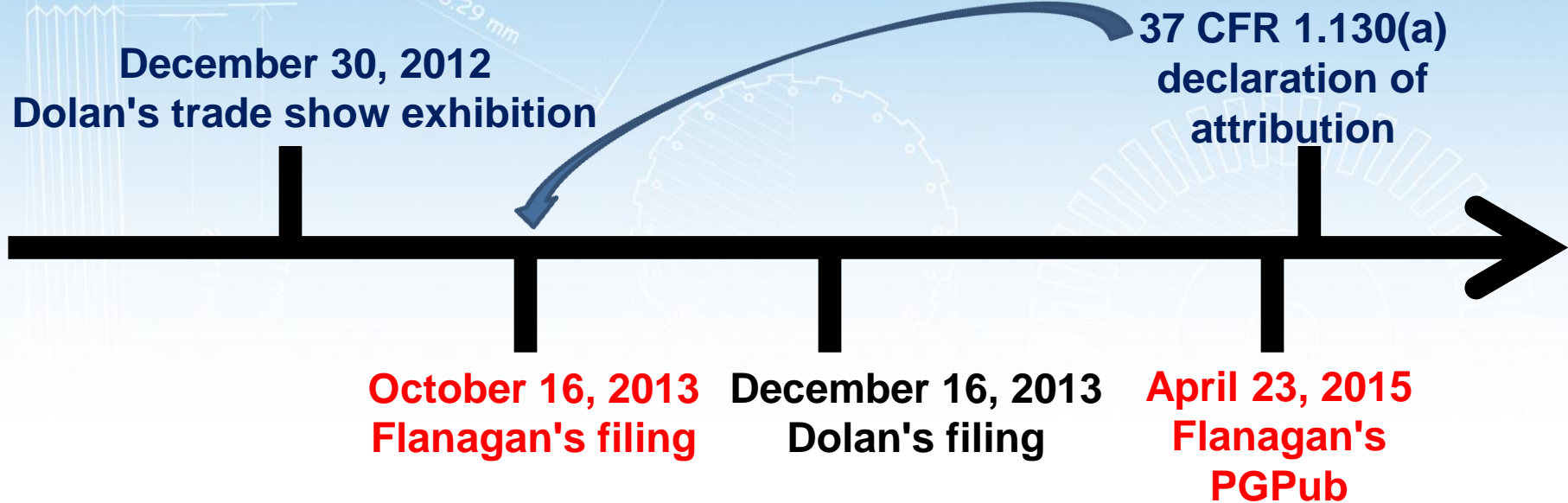
Agenda Excerpt – Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



Question: Can Dolan's attorney submit a declaration under 37 CFR 1.130(a) to establish that the subject matter disclosed in Flanagan's application was invented by Dolan, and that Flanagan obtained it directly or indirectly from him?



Agenda Excerpt – Scenario 2. Traversing a Rejection under 35 U.S.C. 102(a)(2)



YES. Dolan can invoke the 35 U.S.C. 102(b)(2)(A) exception by submitting a declaration under 37 CFR 1.130(a) showing that Flanagan's disclosure of widget X was directly or indirectly obtained from Dolan, who invented it.



America Invents Act First Inventor to File Roadshow

Effective Use of AIA (FITF) Evidentiary Declarations



Agenda Excerpts – Use of AIA (FITF) Evidentiary Declarations

- New Rule 37 CFR 1.130 and Evaluation of Declarations
 - 130(a) Declarations of Attribution
 - 130(b) Declarations of Prior Public Disclosure
 - 37 CFR 1.77(b)(6) Statements
- Formal Requirements for 130 Declarations
- Examples of 130(a) and (b) Declarations
- Points to Consider after Filing 130 Declarations
- Comparison of Declarations for Pre-AIA and AIA Applications



Agenda Excerpts – Declarations under 130(a) and 130(b)

Declaration Rule	Applicable Exception	Purpose
130(a)	102(b)(1)(A) and (b)(2)(A)	<u>attribution</u> : showing that the potential prior art subject matter originated with one or more members of the inventive entity
130(b)	102(b)(1)(B) and (b)(2)(B)	<u>prior public disclosure</u> : showing that the potential prior art subject matter was preceded by an inventor-originated disclosure of the same subject matter

Note that a statement is sufficient (i.e., a declaration is not required) to invoke the 102(b)(2)(C) common ownership exception.



Agenda Excerpts – Example 1: 130(a) Declaration to Invoke 102(b)(1)(A)

130(a)



That's my work!

Al & Bob are authors of a
journal article disclosing X



Applicant's Reply: The attorney for Acme Corp. files a 130(a) declaration signed by Al averring that Al is the sole inventor of X as disclosed in the journal article. Al also explains in the declaration that Bob was a graduate student working under his direction and supervision, and that Bob did not contribute to the conception (i.e., Bob was not an inventor) of X.

Question: Is the declaration sufficient to disqualify the disclosure of X in Al and Bob's journal article as prior art?



Agenda Excerpts –

Example 1: 130(a) Declaration to Invoke 102(b)(1)(A)

130(a)



That's my work!

Answer: Yes.

The declaration is sufficient to establish that the disclosure of X in the journal article is not prior art.

- Because Al avers that invention X originated from him, an inventor's oath/declaration under 37 CFR 1.63 is not necessary to overcome the rejection.
- Al provides a reasonable explanation of Bob's involvement.
- There is no evidence in the record that contradicts the declaration. For example, the specification of the application under examination does not state that Al and Bob both invented X.

A declaration from Bob stating that he did not invent X is not required. See *In re Katz*, 215 USPQ 14 (CCPA 1982) and MPEP 717.01(a)(1).



Agenda Excerpts – Comparison of Declarations for Pre-AIA and AIA Applications

Purpose	Current Rule (as of MPEP 9th ed.)	
	Pre-AIA (First-to-Invent) Applications	AIA (First-Inventor-to-File) Applications
Earlier date of invention (formerly rule 131)	131(a)	Not available
Attribution (Katz Type Declaration)	132	130(a)
Prior public disclosure	Not available	130(b)
Rare current common ownership <u>declaration</u> with terminal disclaimer (not the more frequently used common ownership statement under pre-AIA 103(c) or AIA 102(b)(2)(C))	131(c) Formerly pre-AIA 130(a)	Not available
Other traversal of rejection or objection (e.g., unexpected results, commercial success, etc.)	132	132



Agenda Excerpts - USPTO Home Page



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New Alexandria Headquarters Visitor Access Policy

As of August 4, 2014, the USPTO instituted new access control procedures that may affect visitors to the Alexandria campus.





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Questions and Comments?

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